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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,998

08/11/2005

Lars Daehne

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EXAMINER

LIU, SUE XU

ART UNIT

PAPER NUMBER

1639

MAIL DATE

DELIVERY MODE

12/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,998	Applicant(s) DAEHNE ET AL.	
	Examiner SUE LIU	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 26-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Status

1. Claims 1-25 have been canceled as filed on 2/2/05.
Claims 26-50 are currently pending.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 26-48, drawn to a capsule comprising an envelope having at least three layers.

Group 2, claim(s) 49 and 50, drawn to a composition comprising multiple distinct capsules.

3. The inventions listed as Groups 1 and 2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The common technical feature (i.e. a capsule with an envelope of at least three layers with at least one layer labeled with a dye) of Group 1 is known in the prior art. For example, Dai et al (Advanced Materials. Vol 13: 1339-1342; 2001; cited in IDS) teach a capsule having multiple outer layers (at least three layers), which the capsule has a diameter less than 100 μm

Art Unit: 1639

(see Figure 3; p.1341). The Dai reference also teaches dyes were deposited on the layer surface (e.g. p.1341, last para), which reads on the dye labeled layers. The Dai reference also teaches the layers are polyelectrolytes (e.g. p.1340, left col.). In addition, Antipov et al. (WO 02/017888; 3/7/2002; cited in IDS), teach similar particles having multiple outer layers with dye labels (e.g. Abstract). The Antipov reference also teaches the particles having sizes ranging from 4-9 μm (e.g. Abstract) as well as shells with dye labeled polymers (e.g. Figure 15). Thus, the common technical feature of “a capsule” is known in the prior art.

Therefore, the inventions lack unity as demonstrated by showing the common technical feature(s) does not “define a contribution over the prior art” “*a posterior*”. See MPEP 1850.

4. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Applicants are requested to further elect **a single ultimate species for each** of the following:

- a. A single specific number of layer(s) that is (are) layer that is labeled with dye(s). (for Groups 1-3).
- b. A single specific selection of a specific “layer” that is not labeled with dye. (For Groups 1-3).
- c. A single specific species of a dye. (For Groups 1-3).
- d. A single specific selection of a capsule either with **OR** without additional layers. (For Groups 1-3; e.g. see claim 33)

Art Unit: 1639

- e. A single specific selection of a capsule either with **OR** without a solid core. (For Groups 1-3; e.g. see claim 45)

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

- 5. The claims are deemed to correspond to the species listed above in the following manner:

Please see the above species selection for correspondence between the claims and the species selection.

The following claim(s) are generic: 26-50.

- 6. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Art Unit: 1639

The species lack the same technical feature, because they do not share a common core structure and/or function. The different species would also differ in their reactivity and the starting materials from which they are made. For examples, the different species of assaying methods use different reagents/method steps, which species do not share the same core structure and do not have the same function. Similarly, the different species of “compounds” are also structurally and/or functionally different from each other as they do not share a common core structure. For different species of method, the method steps for each species would differ. Consequently, the species have different issues regarding patentability. Thus the unity of invention between each species subgroup is lacking.

7. Applicant is advised that the reply to this requirement to be complete must include **(i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue Liu whose telephone number is 571-272-5539. The examiner can normally be reached on M-F 9am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached at 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Sue Liu/
Patent Examiner, AU 1639
12/5/08